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EXAMINER

ANDERSON, FOLASHADE

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/820,470  
Filing Date: April 07, 2004  
Appellant(s): ENDLER ET AL.

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Thomas F. Lebens  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 12/08/2009 appealing from the Office action mailed 07/08/2009.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

<b>7,181,410</b>	<b>Jones et al</b>	<b>2-2007</b>
<b>7,139,722</b>	<b>Perrella et al</b>	<b>11-2006</b>
<b>6,937,853</b>	<b>Hall</b>	<b>8-2005</b>
<b>2004/0203901</b>	<b>Wilson et al</b>	<b>10-2004</b>

**Official Notice**

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-16 and 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim,

Art Unit: 3623

the method is not a patent eligible process under §101 and is non-statutory subject matter.

With respect to independent claim 1, the claim language recites the steps of detecting, identifying, selecting, etc.; however the claim language does not include the required tie or transformation. Further the after-final amendment adding "performed by a processor" to the preamble, is considered a nominal tie that does not satisfy the machine or transformation requirement, wherein a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).

Claims 2-16 and 23 are rejected based upon the same rationale, wherein the claim language does not include the required tie or transformation.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3623

3. Claims 1, 9, 10, 15-17, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al (US Publication 2004/0203901) in view of Jones et al (US Patent 7,181,410 B1).

Claim 1 Wilson teaches a **method comprising:**

- **detecting a plurality of participants** (0039 system obtain a request from a first mobile device for a meeting with a person associated with a second mobile device);
- **detecting a location of each of the plurality of participants** (0039, the system automatically determines locations of the first and second mobile device);
- **identifying a plurality of possible meeting locations based on a parameter** (0093, the portal receives from the location engine a list of all POI's fulfilling the user's desired criteria, where POI is a location).
- **selecting a meeting location from the plurality of possible meeting locations based on the location of each of the plurality of participants** (0039, automatically provides information to at least the first or second mobile device regarding a meeting location based at least in part on the determined location of the first or second mobile device, also see 0098); and
- **displaying the meeting location on a screen** (0093, provides to the user's wireless device a POI display, #214 of fig 2A, and figure 9)

Wilson further teaches that the use can narrow the locations selection by for example categories “restaurants, bars, parks, cafes, etc” however it is not expressly taught that the location selection takes amenity preferences in to consideration.

Jones teaches in an analogous art for the purpose of goal oriented travel:

- **detecting a plurality of amenities preferences from the plurality of participants** (col. 7, lines 35-37);
- **selecting a meeting location from the plurality of possible the plurality amenities preferences** (col. 7, lines 42-44)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Wilson the **amenities preferences** as taught by Jones since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 9 Wilson teaches **location of one of participants is a current location detected through a device detection module** (0049, the GMLC includes a phone locator subsystem that work with the GMLC such as the e-Mobility Location Center provided by Nortel).

Claim 10 Wilson teaches **the location of one of participants is a projected location based on a previous location of the participant at a time and date which corresponds to a time and day of a possible meeting** (0039).

Claim 15 Wilson teaches **parameter a geographic area** (0092, user selects a neighborhood/city/sites and provides this information to the portal and 0093, the user's desired criteria).

Claim 16 Wilson teaches **the meeting location is geographically located between the location of each of the participants** (0098, coordinate a meeting equidistant between these friends and the user. The system via the location engine computes a midpoint between the user and friends and performs the functions above to permit the user to identify a desired POI at this midpoint or "geographic center").

Claim 17 and 29 which are directed toward the system and medium respectively for implementing the method of claim 1 is substantially similar to claim 1 and is therefore rejected for the same reasoning given above with regards to claim 1.

4. Claims 2-5, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al (US Publication 2004/0203901) and Jones et al (US Patent 7,181,410 B1) as applied to claim 1 and in further view of Perrella et al (US Patent 7,139,722).

Claim 2 Wilson is silent on **determining a mode of transportation for each of the plurality of participants.**

Perrella teaches **determining a mode of transportation for each of the plurality of participants** (col. 5, lines 21-26) in an analogous art for the purpose of calculating estimated arrive times to a meeting.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Perrella in the invention of Wilson to allow



Art Unit: 3623

notification of the user's timeliness to other meeting participants (Perrella col. 1, lines 46-49).

Claim 3-5 which are direct to a specific mode of transportation i.e. **car, bus, foot** Wilson is silent on these features. However official notice is taken that **car, bus, foot** were old and well known know modes of transportation at the time the invention was made as evidenced by Perrella (col. 5 lines 22-23).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the any old and well know mode of transportation in the invention of Wilson to allow notification of the user's timeliness to other meeting participants (Perrella col. 1, lines 46-49).

Claim 7 Wilson and Perrella are silent on **determining the mode of transportation for each of the plurality of participants is based on a time and day of a possible meeting.**

Jones teaches **determining the mode of transportation for each of the plurality of participants is based on a time and day of a possible meeting** (abstract) for the purpose of goal oriented travel.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Jones in the invention of Wilson to ensure the user's arrive at the meeting on time (col. 1, lines 42-44).

Claim 8 Wilson and Perrella are silent on **determining the mode of transportation for each of the plurality of participants is based on a speed of movement of each of the plurality of participants.**

Jones teaches **determining the mode of transportation for each of the plurality of participants is based on a speed of movement of each of the plurality of participants** (abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Jones in the invention of Wilson to ensure the user's arrive at the meeting on time (col. 1, lines 42-44).

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al (US Publication 2004/0203901) Jones et al (US Patent 7,181,410 B1) and Perrella et al (US Patent 7,139,722) as applied to claim 2 and in further view of Hall (US Patent 6,937,853 B2).

Claim 6 Wilson teaches **selecting the meeting location** (0098); however Wilson is silent that this selection **is based on the mode of transportation for each of the plurality of participants**.

Perrella is silent on **selecting the meeting location is based on the mode of transportation for each of the plurality of participants**. However Perrella takes into the mode of transportation when predicting a user's meeting arrival time (col. 5, lines 20-24)

Hall teaches **selecting the meeting location is based on the mode of transportation for each of the plurality of participants** (col. 1, lines 55-65, where a fleet of vehicles is equivalent to the mode of transportation) in an analogous art for dynamically updating data.

It would have been obvious to one of ordinary in the art at the time the invention was made to include the teachings of Hall in the invention of Wilson to allow for accurate accounting for a common acceptable meeting time among meeting participations

6. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al (US Publication 2004/0203901) and Jones et al (US Patent 7,181,410 B1) as applied to claim 1 and in further view of Official Notice.

Claims 11 and 12 which are directed toward a specific type of meeting location, parameter i.e. **food service, beverage service**. Official notice is taken that **food service, beverage service** were old and well known location types at the time the invention was made as evidenced by Wilson (0092, categories may include for example, restaurants, bars).

Further the Examiner holds that specifying a specific type of parameter is nonfunctional material and is not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP, 2106

Claims 13 and 14 are similar in scope to claims 11 and 12 in that they are directed toward nonfunctional material as such and are rejected for the same reasoning given in regards to claims 11 and 12.

7. Claims 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al (US Publication 2004/0203901), Jones et al (US Patent 7,181,410 B1), Perrella et al (US Patent 7,139,722) and Hall (US Patent 6,937,853 B2).

Claim 23 is substantially similar in scope to claims 1, 2, 6, and 8 and is therefore rejected for the same reasoning given above with regards to these claims. Additional claim 23 recites the additional limitation of **confirming the mode of transportation based on the speed of movement**. This limitation is taught by Jones (col. 4, lines 3-5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Jones in the invention of Wilson, Perrella and Hall to ensure the users arrive at the meeting on time (col. 1, lines 42-44).

#### **(10) Response to Argument**

In the Appeal Brief, Appellant argues that:

1. With respect to the 35 U.S.C. 101 rejection drawn to claims 1-16 and 23 are specifically tied to a machine, consistent with the requirements

under the In re Bilski, 545 F.3d 943 decision. (Appeal p. 14 at par. 4 and p. 15 at par. 2).

2. With respect to the 35 U.S.C. 103(a) rejection drawn to claim 1, the combination of the prior art references of Wilson and Jones fail to describe or suggest at least "identifying a plurality of possible meeting locations based on at least the amenities preferences" AND "selecting a meeting location from the plurality of possible meeting locations based on at least the location of each of the plurality of participants." (Appeal p. 16 at first full paragraph).
3. With respect to the 35 U.S.C. 103(a) rejection drawn to claim 17, the combination of the prior art references of Wilson and Jones fail to describe or suggest at least "means for identifying a plurality of possible meeting locations based on at least the amenities preferences" AND "means for selecting a meeting location from the plurality of possible meeting locations based on at least the location of each of the plurality of participants." (Appeal p. 17 at par. 5).
4. With respect to the 35 U.S.C. 103(a) rejection drawn to claim 29, the combination of the prior art references of Wilson and Jones fail to describe or suggest at least "identifying a plurality of possible meeting locations based on at least the amenities preferences" AND "selecting a meeting location from the plurality of possible meeting locations

based on the location of each of the plurality of participants." (Appeal p. 19 at par. 3).

5. With respect to the 35 U.S.C. 103(a) rejection drawn to claim 23, the combination of the prior art references of Wilson, Jones, Hall, and Perrella fail to describe or suggest at least "selecting the meeting location based on the mode of transportation." (Appeal p. 22 at par. 1).
6. With respect to the 35 U.S.C. 103(a) rejection drawn to claim 23, the combination of the prior art references of Wilson, Jones, Hall, and Perrella fail to describe or suggest at least "selecting the meeting location based on the mode of transportation." (Appeal p. 24 at first full paragraph).

With respect to argument (1), the Examiner respectfully disagrees with Applicant's assertion. To be considered patent eligible subject matter for a method claim under Bilski the claim must be neither tied to a particular machine or apparatus, or transform a particular article to a different state or thing. Here the Applicant asserts that claims 1 and 23 satisfy the machine tie of the Bilski test. While it is true that claims 1 and 23 recite "[a] method performed by a processor-based machine comprising," the tie is contained in the preamble not functionally involved in the method steps and therefore has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process

Art Unit: 3623

steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Further it is noted that the preamble is not necessary to give life, meaning, and vitality' to the claim, and therefore the claim's preamble has not been construed as if a limitation of the claim. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). Finally in a recent board decision it was held that with respect to a non-limiting preamble similar to the one of the instant claim that, "[the] recitation is so generic as to encompass any computing system . . . the recitation of a computer apparatus in the preamble is not, in fact, a limitation at all to the scope of the claim, and the claim is directed . . . to the method performed by any means." *Ex parte Langemyr*, No. 2008-1495 at 20-21 (Bd. Pat. App. & Int. 2008).

With respect to arguments (2) through (4), the Examiner respectfully disagrees with Applicant's assertion. Wilson teaches "identifying a plurality of possible meeting locations based on at least the amenities preferences" (0093, the portal receives from the location engine a list of all POI's fulfilling the user's desired criteria, where POI is a location) and "selecting a meeting location from the plurality of possible meeting locations based on at least the location of each of the plurality of participants" (0039, automatically provides information to at least the first or second mobile device regarding a meeting location based at least in part on the determined location of the first or second mobile device, also see 0098).

The crux of Applicant's arguments appears to be the "a meeting selection module" (instant application par. 0033, see publication 2005/0243165) where "the

Art Unit: 3623

selection module selects a location for multiple users to convene” (instant application par. 43), whereas the Applicant correctly states Wilson teaches, “automatically provides information to at least the first or second mobile device regarding a meeting location . . . wherein the user chooses a particular POI from the list,” (Appeal p. 16 at par. 2). The Examiner points out that the actual language of the claimed limitation is “identifying a plurality of possible meeting locations based on at least the amenities preferences” and “selecting a meeting location from the plurality of possible meeting locations based on at least the location of each of the plurality of participants.” Neither of which indicates that the action of identifying or selecting is done by a module i.e. without a human. The rejection is maintained based on the long standing principle of claim interpretation that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). To interpret the claim to read as anything except for simply selecting would be reading the specification in to the claim; therefore the claims have been given the broadest reasonable interpretation in light of the specification and consistent with what one of ordinary skill in the art would reach. (See, instant specification figure 6 and par. 0073-0074 where the location is selected ambiguously based on the parameter inputs of the user par. 0064).

It is noted that even if the module that “select[s] a meeting location from the plurality of possible meeting locations based on at least the location of each of the plurality of participants” is amended in to the claim. Wilson would still render the limitation obvious; since it is not 'invention' to broadly provide a mechanical or automatic



Art Unit: 3623

means to replace manual activity which accomplishes the same result. *See In re Venner*, 120 USPQ 192 (CCPA 1958); *In re Rundell*, 9 USPQ 220 (CCPA 1931).

Finally it is noted that Wilson teaches a means for "identifying a plurality of possible meeting locations based on at least the amenities preferences" AND "selecting a meeting location from the plurality of possible meeting locations based on at least the location of each of the plurality of participants." (figures 7b, 10-13, 41 and accompanying text). Wilson also teaches a computer readable medium (0062 and 0180).

With respect to arguments (5) and (6), the Examiner respectfully disagrees with Applicant's assertion. Hall teaches selecting the meeting location based on the mode of transportation (col. 1, lines 55-65, where a fleet of vehicles is equivalent to the mode of transportation). In describing the mode of transportation as personal transportation available such as bicycles, motorcycles, cars, and the like" (instant specification 0053) or "for example a participant only has access to a car between limited hours," (instant specification 0054). Where it is old and well known that fleet of vehicles is inclusive of at least a bicycles, motorcycles, cars. Hall further teaches "[m]eeting timing and location constraints for a potential meeting participant may be based on direct measurement of time and location preference . . . in communication with the system may specify the meeting participants and their mobility characteristics, and have the system coordinate the meeting location and time based on the participants' abilities to reach each other." (col. 2, lines 48-59). The teachings of Hall would render the claimed limitation obvious to one of ordinary skill in the art at the time the invention was made.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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